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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,454	11/02/2001	Paul Jollez	6670/OJ997	7397

7590 07/31/2003

Mr. S. Peter Ludwig
DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

HALPERN, MARK

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/008,454	Applicant(s) JOLLEZ ET AL.	
	Examiner Mark Halpern	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5/15/02</u> . | 6) <input type="checkbox"/> Other: _____ |



5/15/02

FORM PTO-1449

DEPARTMENT OF COMMERCE PATENT & TRADEMARK OFFICE

SHEET 1 OF 1
(REV. 7-80)

LIST OF REFERENCES CITED BY APPLICANT

(Use Several Sheets If Necessary)

DOCKET NO.: 6670/OJ997
APPLICANT: Paul JOLLEZ

SERIAL NO: 10/008,454
FILING DATE: November 2, 2001
CONFIRMATION NO: 7397

U.S. PATENT DOCUMENTS

*EXAMINER INITIALS	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE
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FOREIGN PATENT DOCUMENTS

*EXAMINER INITIALS	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES
MH	1. 99/60027	Nov. 1999	PCT ✓	C08B	15/08	
MH	2. 1792942	Feb. 1986	Soviet Union	C08B	1/00	Abstract only
MH	3. 0170530	Jul. 1989	Europe	C13K	1/02	
MH	4. 7-102074	Apr. 1995	Japan	C08J	3/12	Abstract only
MH	5. 9-278674	Oct. 1997	Japan	A61K	47/36	Abstract only
	6. 2,137,890	Dec. 1994	Canada	C08B	15/00	
	7. 1,198,703	Dec. 1985	Canada	C08B	1/00	
	8. 2,313,261	May 1998	Canada	C08B	15/08	

OTHER REFERENCES

(INCLUDING AUTHOR, TITLE DATE, PERTINENT PAGES, ETC.)

*EXAMINER
INITIALS

EXAMINER:

M. Halper

DATE CONSIDERED:

RECEIVED

MAY 24 2002

TC 1700

7/11/03

*EXAMINER: If reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

DETAILED ACTION

Specification

- 1) The Specification on page 1, should include a Cross-References to Related Application: See 37 CFR 1.78 and MPEP § 201.11.

Claim Objections

- 2) Claims 4-13, are objected to under 37 CFR 1.75(c) as being in improper form because multiple dependent claims 4-13, depend from any of preceding claims. See MPEP § 608.01(n). Accordingly, the claims 4-13, are not been further treated on the merits.
- 3) Claims 2-13, line 1, said dependent claims should start with the term –The- in place of “A”.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 4) Claims 1-13, are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 1, in process step (e) fails to recite that the cooked pulp is being hydrolyzed to form microcrystalline cellulose without the use of any mineral acids, which is critical or essential to the practice of the invention, but not

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included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527

F.2d 1229, 188 USPQ 356 (CCPA 1976).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5) Claims 1-13, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, appears to be incomplete since the step of recovering the microcrystalline cellulose has been omitted.

Claim 1, step (b) is not complete since the step of pressing of the pulp does not indicating the purpose of removing water.

Claims 1, 5: correct spelling is required of words "polymerization" and "depressurizing".

Claim 11, line 3, includes a trademark name DEQUEST. Trademark products are not permitted in claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6) Claims 1-3, are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshkov (3,954,727) in view of Jollez (WO 99/60027) and further in view of Nimz (5,074,960).

Claim 1: Toshkov discloses a process of preparing microcrystalline cellulose. The pulp is placed into a reactor and cooked by heating the reactor at a desired temperature and pressure for a duration of time to obtain a desired degree of polymerization. Process temperature, pressure and duration are disclosed. (Toshkov, col. 2, lines 28-68). After cooking the reactor is cooled with water. It would have been obvious that water-cooling of the reactor would necessitate a partial depressurizing of the reactor in order to keep structural integrity of the reactor. The obtained product, microcrystalline cellulose, is filtered, bleached and dried (Toshkov, col. 2, lines 28-63). Toshkov is silent as to repulping of the pulp, pressing and decompaction prior to placing into a reactor. Jollez discloses a process of making high purity microcrystalline cellulose, which includes the steps of preparing a pulp by repulping, filtration and trituration prior to placement into a reactor for cooking. It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Jollez and Toshkov, because such a combination would provide a product of Toshkov utilizing an environmentally friendly process as disclosed by Jollez (pg. 3, lines 21-26, and pg. 7, line 30 to pg. 8, line 5). It would have been obvious to preheat the reactor to a desired temperature prior to placing the pulp into the reactor because it would reduce the microcrystalline cellulose formation time and provide better control of the process, which is desired and disclosed by Jollez (pg. 9, lines 24-29). Toshkov is silent on

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pressing and decompacting in the pulp preparation. Nimz discloses a process of preparing alpha-cellulose (col. 3, lines 35-38), which include the steps of pressing and then fluffing of the pulp prior to reaction (Nimz, col. 7, lines 44-54). It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Nimz and Toshkov, because such a combination would provide improved brightness in the product of Toshkov as disclosed by Nimz (col. 2, lines 36-43).

Claim 2: repulping is carried out at a consistency of 2 % (Jollez, pg. 12, line 19).

Claim 3: cooking is carried out with the addition of diluted hydrochloric acid (Toshkov, col. 1, lines 21-25).

Conclusion

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application is assigned are 703-872-9310/9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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July 25, 2003

Mark Halpern
Patent Examiner
Art Unit 1731

A handwritten signature in black ink, appearing to read "Peter Chin", with a stylized flourish at the end.

PETER CHIN
PRIMARY EXAMINER